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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,324	08/23/2001	Tully Michael Underhill	3477.92	6862

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EXAMINER

AZPURU, CARLOS A

ART UNIT PAPER NUMBER

1615

DATE MAILED: 04/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/856,324	Applicant(s) UNDERHILL ET AL.	
	Examiner Carlos A. Azpuru	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-65 is/are pending in the application.
- 4a) Of the above claim(s) 35-42, 51-58 and 60-65 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 43-49 and 59 is/are allowed.
- 6) ☒ Claim(s) 50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of the amendment filed 01/09/2006.

Applicant's arguments, filed 01/09/2006, with respect to the rejection under 35 USC 103(a) over Standeven et al in view of Koyama et al have been fully considered and are persuasive. In addition, a review of the article by Koyama et al appears to teach away from RAR-antagonist mediated chondrogenesis (see Abstract). The rejection of claims 43-50 and 59 has been withdrawn.

A review of the application find the following:

Specification

The disclosure is objected to because of the following informalities: The specification lacks a "Brief Description of the Drawings". Also the listing of references in pages 33-41 should be deleted.

Appropriate correction is required.

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a

separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 50 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 50 sets out a treatment for arthritis.

The following is analysis of the most pertinent Wands factors:

The factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. 112, first paragraph, have been described in *In re Wands*, 8 USPQ2d 1400 (Fed. Cir. 1988). Among these factors are: (1) the nature of the invention; (2) the state of the prior art; (3) the relative skill of those in the art; (4) the predictability or unpredictability of the art; (5) the breadth of the claims; (6) the amount of direction or guidance presented; (7) the presence or absence of working examples; and (8) the quantity of experimentation necessary. When the above factors are weighed, it is the examiner's position that one skilled in the art could not practice the invention without undue experimentation.

(1) The nature of the invention:

The invention provides a method of inducing chondrogenesis through administration of an RAR antagonist in a pharmaceutically effective carrier.

(2) The state of the prior art

Prior art does have a suggestion of administering viscosupplement composition, but does not have a teaching of administering RAR antagonist compositions in conjunction with them

(4) The predictability or unpredictability of the art

The unpredictability of the peptide art is very high. While various method of treating arthritis have been proposed, no treatment to date has been able to reverse the progression of arthritis.

(5) The breadth of the claims

The claim very broadly sets out a treatment for arthritis.

(6) The amount of direction or guidance presented

The specification lacks and guidance as to the treatment of arthritis except for the possible administration step.

(7) The presence or absence of working examples

None of the working examples are directed to providing data showing a treatment for arthritis.

(8) The quantity of experimentation necessary

Since the administration of the RAR antagonist has not been tested for arthritic patients, there is no way to predict whether this represents an effective treatment of arthritis. Since there are various etiologies for this disease, applicant would need to provide histological evidence showing a change in the degenerative aspects of the disease over a period of time. This would entail an extensive amount of experimentation which has not been provided in the instant application.

As such, the instant application is not enabled for a treatment of arthritis.

Allowable Subject Matter

Claims 43-49 and 59 are allowed.

Conclusion

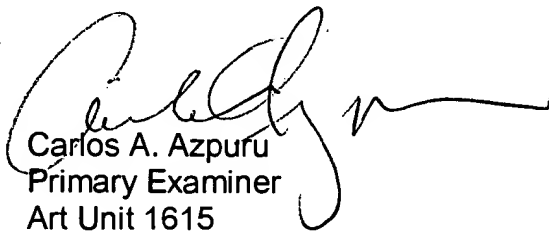
Cancellation of the non-elected claims would place the application in condition for allowance.

Applicants remarks have been noted. However, only claims 51-54 would be rejoined since they are commensurate in scope with the allowed claims. Further, the previously cited references would read on claim 51. Applicant can expect at least one more action if these claims are pursued.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos A. Azpuru whose telephone number is (571) 272-0588. The examiner can normally be reached on Tu-Fri, 6:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Carlos A. Azpuru
Primary Examiner
Art Unit 1615

ca